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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,692	09/26/2003	Satoshi Hiratsuka	YAMA:059	9284
37013	7590	10/24/2008		
ROSSI, KIMMS & McDOWELL LLP. 20609 Gordon Park Square, Suite 150 Ashburn, VA 20147			EXAMINER	
			WILLIAMS, JEFFERY L.	
			ART UNIT	PAPER NUMBER
			2437	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/672,692	<b>Applicant(s)</b> HIRATSUKA, SATOSHI
	<b>Examiner</b> JEFFERY WILLIAMS	<b>Art Unit</b> 2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 July 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 7/17/08
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

2

3 Claims 1 – 11 are pending.

4

## **Specification**

6

7 The specification is objected to as failing to provide proper antecedent basis for  
8 the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction  
9 of the following is required:

10 The specification fails to provide proper antecedent basis for the recitation or to  
11 *another information processing terminal logged in by the same user.*

12

### **Claim Rejections - 35 USC § 112**

14

15 The following is a quotation of the first paragraph of 35 U.S.C. 112:

16

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

21

22 with the written description requirement. The claim(s) contains subject matter which  
23 was not described in the specification in such a way as to reasonably convey to one  
24 skilled in the relevant art that the inventor(s), at the time the application was filed, had  
25 possession of the claimed invention. Applicant has not pointed out where the new (or

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1 amended) claim is supported, nor does there appear to be a written description of the  
2 claim limitations in the application as filed (see above objection to the specification).

3  
4

## ***Claim Rejections - 35 USC § 102***

6

7 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that  
8 form the basis for the rejections under this section made in this Office action:

9 A person shall be entitled to a patent unless –

10 (b) the invention was patented or described in a printed publication in this or a foreign country or in public  
11 use or on sale in this country, more than one year prior to the date of application for patent in the United  
12 States.

14 **Claims 1 – 11 are rejected under 35 U.S.C. 102(b) as being anticipated by**

15 Nozaki et al., (Nozaki), US Patent Publication 2002/0036800 A1.

16

17 Regarding claim 1, Nozaki discloses:

18 A contents supplying server apparatus that supplies contents for downloading via  
19 a communication network; and an information processing terminal that receives the  
20 contents from the server apparatus for at least one user (fig. 2:1, 2a)

21        *Wherein the server apparatus comprises: a server storing device for storing,*  
22        *together with numerous contents, user information for each user, including user ID*  
23        *information and contents purchase information comprising contents ID information and*  
24        *copy control data (fig. 3:8 - herein Nozaki discloses a server storing device):*

25 and a server controlling section that, in response to a request from a user for  
26 copying the downloaded contents from said information processing terminal to an

1        *external apparatus or recording medium (par. 14, 21, 103), reads out the copy control*  
2        *data of the requested downloaded contents to be copied to the external apparatus or*  
3        *recording medium from the server storing device, supplies the copy control data of the*  
4        *user to said information processing terminal, and amends the copy control data of the*  
5        *user corresponding to the request stored in the server storing device (par. 62, 63, 105-*  
6        *107),*  
7                *and wherein the information processing terminal comprises: a terminal storing*  
8        *device for storing the downloaded contents from the server apparatus (fig. 4:21);*  
9                *a sending section for sending to the server apparatus the request for copying the*  
10        *downloaded contents to the external apparatus or recording medium; a receiving*  
11        *section for receiving the copy control data of the downloaded contents to be copied to*  
12        *the external apparatus or recording medium from the server apparatus (fig. 4:28, 30,*  
13        *36);*  
14                *and a terminal controlling section for determining whether or not to copy said*  
15        *downloaded contents to the external apparatus or recording medium based on the*  
16        *received copy control data (fig. 4:35).*  
17  
18        Regarding claim 2, Nozaki discloses:  
19                *wherein the copy control data stored in said server storing device represents the*  
20        *number of times the downloaded contents are allowed to be copied to the external*  
21        *apparatus or recording medium, and is decremented every time the downloaded*

1    *contents are copied from the information processing terminal into the external apparatus*  
2    *or recording medium (par. 63, 73, 80).*

3

4        Regarding claim 3, Nozaki discloses:

5            *wherein the user information of said server storing device further includes*  
6            *terminal ID information representing one or more information processing terminals (par.*  
7            *89, 101),*

8            *and said server controlling section supplies the already downloaded contents by*  
9            *the same user without executing a fee-charging process to the information processing*  
10          *terminal that has already downloaded the downloaded contents or to another*  
11          *information processing terminal logged in by the same user (par. 12-17 – Nozaki does*  
12          *not disclose executing a fee charging process for previously owned contents).*

13

14        Regarding claim 4, Nozaki discloses:

15            *wherein said server storing device stores an initial value of the copy control data,*  
16          *contents by contents (par. 63).*

17

18        Regarding claim 5, Nozaki discloses:

19            *wherein said contents are music data (par. 28).*

20

21        Regarding claims 6 – 11, they are program and apparatus claims corresponding  
22          to claims 1 – 5, and they are rejected, at least, for the same reasons.

1  
2       Regarding claims 12 – 14, they recite wherein the external apparatus is an  
3       electronic musical instrument, however, the examiner notes that "the external  
4       apparatus" is not a required limitation of the claims. Therefore, though Nozaki discloses  
5       an apparatus capable of reproducing musical notes or sounds (par. 44), it is not  
6       necessary to address this recitation.

13                   Applicant argues essentially that:

15 (i) ...Applicant traverses this rejection because Nozaki would not have disclosed or  
16 taught at least seeking a request to copy the already downloaded contents from the  
17 server before allowing copying of the same as set forth in independent claims 1, 6, and  
18 9.

19        *Specifically, independent claims 1, 6, and 9 ... thus calls for seeking a*  
20    *permission from the server each time before the already downloaded contents are to be*  
21    *copied.*

1       *...In contrast, the pending claims call for seeking a permission from the server*  
2       *each time a copy is to be made; the server rather provides the updated copy control*  
3       *data to the user terminal (e.g., PC). (Remarks, pg. 6, 7)*

4

5       In response to applicant's argument that the references fail to show certain  
6       features of applicant's invention, it is respectfully noted that the features upon which  
7       applicant relies (i.e., *seeking a permission from the server each time a copy is to be*  
8       *made*) are not recited in the rejected claim(s). Although the claims are interpreted in  
9       light of the specification, limitations from the specification are not read into the claims.

10      See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11

12      (ii)     *In contrast, according to the claimed invention, each time the user on the*  
13       *terminal wishes to copy the already downloaded contents, the terminal has to seek a*  
14       *permission from the server as to whether copying is permitted. The available copy count*  
15       *information cannot be updated at the terminal. In other words, the available copy count*  
16       *information is managed only at the server side. Therefore, the copying can be better*  
17       *restricted in the claimed invention in comparison with Nozaki. As Nozaki would not have*  
18       *disclosed or taught seeking a copy permission from the server each time an already*  
19       *downloaded music data is to be copied, applicant submits that Nozaki would not have*  
20       *disclosed or taught the claimed invention. (Remarks, pg. 7)*

21

1        In response to applicant's argument that the references fail to show certain  
2        features of applicant's invention, it is respectfully noted that the features upon which  
3        applicant relies (i.e., *each time the user on the terminal wishes to copy the already*  
4        *downloaded contents, the terminal has to seek a permission from the server as to*  
5        *whether copying is permitted...The available copy count information cannot be updated*  
6        *at the terminal... the available copy count information is managed only at the server*  
7        *side*) are not recited in the rejected claim(s). Although the claims are interpreted in light  
8        of the specification, limitations from the specification are not read into the claims. See  
9        *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10

11        (iii)    *Moreover, claim 1 further calls for a server controlling section that, in response to*  
12        *a request from a user for copying the already downloaded contents from the information*  
13        *processing terminal to an external apparatus or recording medium, reads out the copy*  
14        *control data of the requested downloaded contents to be copied to the external*  
15        *apparatus or recording medium from the server storing device, supplies the copy control*  
16        *data of the user to the information processing terminal, and amends the copy control*  
17        *data of the user corresponding to the request stored in the server storing device.*  
18        *Applicant submits that Nozaki further would not have disclosed or taught the server*  
19        *functionality set forth in claim 1. (Remarks, pg. 7)*

20

21        In response to the applicant's newly added recitations of "*reads out the copy*  
22        *control data of the requested downloaded contents to be copied to the external*

1 *apparatus or recording medium from the server storing device, supplies the copy control*  
2 *data of the user to the information processing terminal, and amends the copy control*  
3 *data of the user corresponding to the request stored in the server storing device" the*  
4 examiner respectfully directs the applicant's attention to the prior art (e.g. see Nozaki,  
5 paragraphs 14, 21, and 103 – 107).

6

7 ***Conclusion***

8

9 The prior art made of record and not relied upon is considered pertinent to  
10 applicant's disclosure:

11 ***See Notice of References Cited.***

12

13 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time  
14 policy as set forth in 37 CFR 1.136(a).

15 A shortened statutory period for reply to this final action is set to expire THREE  
16 MONTHS from the mailing date of this action. In the event a first reply is filed within  
17 TWO MONTHS of the mailing date of this final action and the advisory action is not  
18 mailed until after the end of the THREE-MONTH shortened statutory period, then the  
19 shortened statutory period will expire on the date the advisory action is mailed, and any  
20 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of  
21 the advisory action. In no event, however, will the statutory period for reply expire later  
22 than SIX MONTHS from the mailing date of this final action.

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1 Any inquiry concerning this communication or earlier communications from the  
2 examiner should be directed to JEFFERY WILLIAMS whose telephone number is  
3 (571)272-7965. The examiner can normally be reached on 8:30-5:00.

4 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
5 supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone  
6 number for the organization where this application or proceeding is assigned is (703)  
7 872-9306.

8 Information regarding the status of an application may be obtained from the  
9 Patent Application Information Retrieval (PAIR) system. Status information for  
10 published applications may be obtained from either Private PAIR or Public PAIR.  
11 Status information for unpublished applications is available through Private PAIR only.  
12 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
13 you have questions on access to the Private PAIR system, contact the Electronic  
14 Business Center (EBC) at 866-217-9197 (toll-free).

15

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18 AU 2437  
19

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23